

REMARKS

By this amendment, Applicants amend claims 1, 34, 58, 101, 144, 145, and 148. Claims 1-13, 15, 17-45, 48-60, 62-103, and 105-149 are pending in this application.

Applicants amend claims 1, 34, 58, 101, 144, and 145 to more appropriately define the claimed subject matter. Applicants also amend claim 148 to correct an informality. These amendments do not add any new subject matter.

§102(b) Rejection of Claims 1-9, 11-13, 15, 17-20, 22-41, 43-45, 48-60, 62-70, 72-103, 105-113, and 115-145 over *Jeffers et al.*

Applicants respectfully traverse the rejection of claims 1-9, 11-13, 15, 17-20, 22-41, 43-45, 48-60, 62-70, 72-103, 105-113, and 115-145 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 4,739,510 to Jeffers et al. ("*Jeffers et al.*"). To properly anticipate Applicant's claims under 35 U.S.C. §102, each and every element as set forth in the claim must be found, either expressly or inherently described, in a single prior art reference. See M.P.E.P. § 2131.

Jeffers et al. fails to disclose each and every element recited in independent claim 1, from which claims 2-9, 11-13, 15, 17-20, and 22-33 depend. For example, *Jeffers et al.* fails to disclose a transmitting method comprising, inter alia, "constructing said additional information in which acquiring information necessary to acquire related data related to said broadcast signal and a second signal are disposed, wherein said broadcast signal comprises said second signal superimposed on a first signal; and transmitting said broadcast signal, and transmitting said additional information, in which said acquiring information concerning said related data related to this broadcast signal

is disposed, on plural occasions during the transmission of said broadcast signal,” as recited in independent claim 1, as amended.

Instead, *Jeffers et al.* teaches, “generating a broadcast signal having active video signal portions and horizontal blanking portions. [An] audio signal and a data stream are generated and inserted into the horizontal blanking portions. The data stream includes a header portion including group address information and program-related information applicable to all of the receiving means and groups of addressable portions associated with the header.” (Col. 5, lines 38-46.)

The Examiner relies on the “broadcast signal” of *Jeffers et al.* as the “broadcast signal” recited in claim 1. The Examiner further relies on the “audio signal” of *Jeffers et al.* as the “second signal” of claim 1, and on the combination of the “audio signal” and “data stream” of *Jeffers et al.* as the “additional information” of claim 1. However, *Jeffers et al.* fails to disclose transmitting a broadcast signal “in which [a] second signal is superimposed also on a first signal,” and also transmitting additional information “in which acquiring information ... and [the] second signal are disposed,” as recited in claim 1.

The Examiner acknowledges that “the claim recites transmission of two components (broadcast signal and additional information” (Office Action, page 2, paragraph 4). Each of these transmitted components is also recited to comprise the “second signal.” However, *Jeffers et al.* fails to teach or suggest that the “broadcast signal” comprises the “audio signal.” Instead, the “broadcast signal” has “active video signal portions” and “horizontal blanking portions,” neither of which constitutes the “second signal” recited in claim 1.

The Examiner asserts, “[t]he claim does not recite the broadcast signal is transmitted, separately from the additional information.” However, regardless of what the Examiner means by “separately” transmitting the broadcast signal and additional information, claim 1 requires transmitting both the “broadcast signal” and the “additional information,” wherein each of these claimed elements comprises the “second signal.” *Jeffers et al.* fails to teach or suggest this limitation of claim 1.

Thus, claim 1 and claims 2-9, 11-13, 15, 17-20, and 22-33 dependent therefrom are allowable over *Jeffers et al.*

For reasons substantially similar to those explained above in relation to claim 1, independent claim 34 is allowable over *Jeffers et al.* Claims 35-41, 43-45, and 48-57 are also allowable over *Jeffers et al.*, for at least the reason that these claims depend from independent claim 34.

Jeffers et al. also fails to disclose each and every element of independent claim 58, from which claims 59, 60, 62-70, and 72-100 depend. For example, *Jeffers et al.* fails to disclose a receiving method comprising, inter alia, “temporarily storing said received additional information into a temporary storage, said additional information being associated with said broadcast signal; and storing said acquiring information disposed in said additional information ... into a main storage when there is a user input from an operation unit while receiving said broadcast signal,” as recited in amended claim 58.

The Examiner states, “[d]epending the channel selected by the user, this header information is stored in the decoder memory if the information in the data stream,” referring to Col. 22, lines 24-61, of *Jeffers et al.* (Office Action, page 3, paragraph 2).

However, the channel selection in *Jeffers et al.* is not input “while receiving said broadcast signal” to which “said additional information” is “associated,” as required by claim 58.

For reasons substantially similar to those explained above in relation to claim 58, independent claims 101, 144, and 145 are allowable over *Jeffers et al.* under §102(b). Claims 102, 103, 105-113, and 115-143 are also allowable over *Jeffers et al.* under §102(b), for at least the reason that these claims depend from independent claim 101.

§103(a) Rejection of Claims 10, 42, 71, 114, and 146-149 over *Jeffers et al.*

Applicants respectfully traverse the rejection of claims 10, 42, 71, 114, and 146-149 under 35 U.S.C. §103(a) as unpatentable over *Jeffers et al.*

To establish a *prima facie* case of obviousness under §103(a), each of three requirements must be met. “First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art,” to combine references or modify a reference. MPEP § 2143 (8th ed. Rev. Feb. 2003). Second, a reasonable expectation of success must exist that the proposed modification will work for the intended purpose. *Id.* Moreover, both of these requirements must “be found in the prior art, not in applicant’s disclosure.” *Id.* Third, the reference or references, taken alone or in combination, must disclose or suggest every element recited in the claims. *Id.*

Claim 10 is allowable over *Jeffers et al.* for at least the reason that *Jeffers et al.* does not teach or suggest each and every element of independent claim 1, from which claim 10 depends. Claim 42 is allowable over *Jeffers et al.* for at least the reason that *Jeffers et al.* does not teach or suggest each and every element of independent claim

34, from which claim 42 depends. Claim 71 is allowable over *Jeffers et al.* for at least the reason that *Jeffers et al.* does not teach or suggest each and every element of independent claim 58, from which claim 71 depends.

Independent claims 148 and 149 are allowable over *Jeffers et al.* for reasons substantially similar to those explained above in relation to claim 58 and 101, respectively.

Independent claim 146 is allowable over *Jeffers et al.* because *Jeffers et al.* does not teach or suggest each and every element recited in the claim. For example, *Jeffers et al.* fails to teach or suggest a transmitting method comprising, inter alia “constructing predetermined additional information which includes acquiring information necessary to acquire data related to a predetermined broadcast signal ..., wherein said related data is a computer program when said broadcast signal is video data or audio data obtained by executing said computer program,” as recited in claim 146.

The Examiner alleges that “it would have been obvious to one skilled in the art at the time the invention was made that the related data of *Jeffers et al.* could have been implemented into software (computer program) in order to obtain the audio and video data.” However, the Examiner’s allegation regarding what would have been obvious to one skilled in the art is inappropriate because the Examiner has not provided any evidentiary support for this allegation. “It is never appropriate to rely solely on ‘common knowledge’ in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based.” MPEP § 2144.03(A) (citing *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697). The Examiner must either point to some concrete evidence in the record in support of his finding of what is known in the art to satisfy the

substantial evidence test, or if the Examiner is relying on personal knowledge to support the finding, the Examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. MPEP § 2144.03(C). Thus, the Examiner should either provide evidentiary support in the record, or the Examiner should withdraw this rejection.

Independent claim 147 is allowable over *Jeffers et al.* for reasons substantially similar to those explained above in relation to claim 146.

CONCLUSION

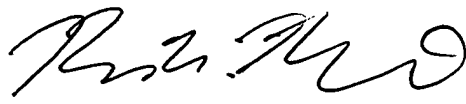
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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